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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,066	06/08/1999	STEPHEN WILLIAM HILLIER	0500.01326	6282

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VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 09/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary

Application No.

09/328,066

Applicant(s)

HILLIER ET AL.

Examiner

Benjamin E Lanier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12, 18-44 is/are rejected.
- 7) ☒ Claim(s) 6-9, 13-17 and 45-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see paper 8, filed 14 July 2003, with respect to the rejection(s) of claim(s) 1-4, 10, 18, 23, 24, 27, 28, 32, 33, 36, 37, and 40-43 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Appelbaum, U.S. Patent No. 4,683,968.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 10, 12, 18, 19, 23, 24, 27, 32, 33, 35-37, 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Appelbaum, U.S. Patent No. 4,683,968. Referring to claims 1-5, 10, 12, 18, 19, 23, 24, 27, 32, 33, 35-37, 40-44, Appelbaum discloses a system for preventing software piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The check program at the computer then performs another

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single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 25, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum, U.S. Patent No. 4,683,968, in view of Perlman, U.S. Patent No. 5,351,295.

Referring to claims 11, 25, and 26, Appelbaum discloses a system for preventing software piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The checker program at the computer then performs another single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract). Appelbaum does not disclose providing a time stamp with the data. Perlman discloses a time stamp that is encrypted and sent along with the data (Col. 2, lines 53-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a time stamp in the system for preventing software piracy of Appelbaum in order to prevent attacks on the data as discloses in Perlman (Col. 2, lines 49-59).

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6. Claims 20-22, 28-30, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum, U.S. Patent No. 4,683,968, in view of Wertheimer, U.S. Patent No. 5,920,630. Referring to claims 20-22, 28-30, 38, 39, Appelbaum discloses a system for preventing software piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The check program at the computer then performs another single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract). Appelbaum does not disclose digitally signing the transmissions from party to party or verifying that the transmissions were received. Wertheimer discloses a method of public key cryptography wherein cryptographic keys are exchange between users and a certifying authority in order to promote secure communication and the message distributions in the system are signed and verifiable via a directory of transmissions (Abstract, Col. 10, lines 10-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to digitally sign the transmissions of Appelbaum and have them verifiable that way the parties in the system of Appelbaum would be able to verify the identity of the transmitter as well as verify that transmissions were received as taught in Wertheimer (Col. 10, lines 10-33, Col. 6, lines 40-50).

Allowable Subject Matter

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7. Claims 6-9, 13-17, 45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

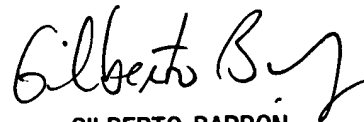
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Benjamin E. Lanier
August 26, 2003



GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100